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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,155	12/01/2003	Raymond V. Damadian	DAMADIAN 3.0-094	1774
530 7590 04/29/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER MEHTA, PARIKHA SOLANKI				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,155

Applicant(s)

DAMADIAN, RAYMOND V.

Examiner

PARIKHA S. MEHTA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 February 2008 has been entered.

Response to Arguments

2. Applicant's amendments to claims 1-22 have been fully considered but are ineffective to overcome the Zuk (US PG Pubs. No. 2002/0123681) reference.

Regarding the newly added limitation of the patient support "having three degrees of motion", the Zuk ('681) support can be moved in any direction in three dimensional space, and therefore it is considered to have "three degrees of motion" as is currently claimed. Applicant does not claim that the support is moveable by any specific means (for example, about a pivot point and/or by a lever as illustrated in Fig. 1 of the present application), and therefore any prior art support that is not permanently affixed to a single location in space can be interpreted as "having three degrees of motion".

Regarding the newly added limitation of the patient support having the three degrees of motion "for positioning a patient... relative to [the] gap", the patient support of Zuk ('681) supports the patient in a position relative to the gap between the magnet as shown in Figs. 1 and 2 of the reference. Moreover, with regard to the statements of intended use and other functional statements ("for..."), they do not impose any structural limitations on the claims distinguishable over Zuk ('681), which is in fact capable of being used as claimed if one so desires to do so [see *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)]. The law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 102

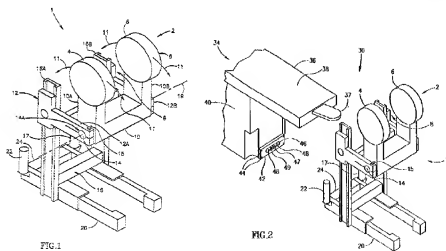
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-7, 9, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Zuk (US Pre-Grant Publication No. 2002/0123681), hereinafter Zuk ('681), previously made of record.

Regarding claims 1, 3-7 and 12-14, Zuk ('681) discloses a U-shaped superconducting magnet **10** having a gap for receiving a patient, and means **17** for moving the magnet so that a portion of a region of interest of the patient can be imaged, the means comprising an electrical motor which may be connected to a jack for lowering or raising the magnet (Fig. 1, ¶ 0019-21, ¶ 0065). Zuk ('681) shows a patient support platform **36** positioned within the gap for supporting the patient (Fig. 2). The patient support platform **36** can be moved in any direction in three dimensional space (e.g., by sliding or lifting the entire system), and therefore it has three degrees of motion as presently claimed. Zuk ('681) also provides vertical support members **16A** for moving the magnet in a vertical direction (Figure 1).



(Source: Zuk (US PG Pubs. No. 2002/0123681), pages 2 & 3)

Zuk ('681) further discloses that the electrical motor may be mechanically coupled to the framework, thereby comprising an electromechanical device (§ 0065).

Regarding claims 21 and 22, Zuk ('681) discloses that the U-shaped magnet may be superconductive (§ 0021).

Regarding claim 17, Zuk ('681) discloses a method of using the aforementioned apparatus, which includes establishing a static magnetic field between the magnet gap of the above-noted apparatus, positioning a patient within a patient receiving space, positioning the magnetic field by vertically translating the magnet, and obtaining an MR image of the patient's anatomy (§ 0015, § 0082). Zuk ('681) provides for the use of a gradient coil as the MRI probe, which inherently supplies a gradient magnetic field for obtaining the patient image (§ 0139). Zuk ('681) further discloses supporting the patient on an operating table, equivalent to a patient support, while in the patient receiving space (§ 0112). Zuk ('681) provides a step for moving the MRI probe into a position suitable for imaging a selected portion of the patient's anatomy, which inherently anticipates lowering the magnet (§ 0092). Zuk ('681) further discloses that screws may be used to mechanically couple the motor to the magnet to control motion of the magnet (§ 0065).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuk ('681) in view of Cho (Foundations of Medical Imaging, Wiley Interscience, © 1993), previously made of record.

Zuk ('681) discloses all features of the present invention as described above, with the exception of explicitly specifying that the U-shaped magnet is a solenoid. It is well-known in the art to use a solenoid in situations where an electromagnet is needed, and it is also well-known that state-of-the-art MRI systems for medical imaging commonly employ solenoids as electromagnets. For example, Cho (1993) states that solenoids are commonly used in medical MR imaging systems (p. 257). Thus, it would

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have been obvious to one of ordinary skill in the art to create a medical imaging system according to Zuk ('681), employing a solenoid for the disclosed electromagnet, in light of the MR imaging techniques known at the time of invention.

7. Claims 8, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuk ('681) in view of Acker (US Patent No. 6,128,522), hereinafter Acker ('522).

Zuk ('681) substantially teaches all features of the present invention, with the exception of expressly teaching a pneumatic or hydraulic device configured to move the magnet. In the same field of endeavor, Acker ('522) teaches hydraulic and pneumatic means for positioning an MR magnet during imaging (col. 8 lines 58-67). It would have been obvious to one of ordinary skill in the art to include the pneumatic or hydraulic device of Acker ('522) as a means of moving the magnet in the system of Zuk ('681), as it has previously been held that the mere combination of known elements to yield predictable results is not a patentable advance over the prior art (see for precedent *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,414,490. Although the conflicting claims are

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not identical, they are not patentably distinct from each other because the instant claims are merely broader than the conflicting claims.

10. Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,677,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are merely broader than the conflicting claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PARIKHA S. MEHTA whose telephone number is (571)272-3248. The examiner can normally be reached on M-F, 8 - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571.272.4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian L Casler/

Supervisory Patent Examiner, Art Unit
3737

/Parikha S Mehta/

Examiner, Art Unit 3737